

Response

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Serial No.: 10/000,057

Confirmation No.: 9505

Filed: November 1, 2001

For: ABRASION RESISTANT COATING FOR STACKS OF FIBER CEMENT SIDING

Remarks

The Office Action mailed 27 June 2005, has been received and reviewed. No claims having been amended, the pending claims are claims 17-19, 21, and 31-52. Reconsideration and withdrawal of the rejections are respectfully requested.

The 35 U.S.C. §103(a) Rejection

The Examiner rejected claims 17-18, 31-32, and 42-50 under 35 U.S.C. §103(a) as being unpatentable over Blum (U.S. Patent No. 5,344,873) in view of Dai Nippon (JP 10-128902). Applicants respectfully traverse this rejection.

A. THERE IS NO SUGGESTION OR MOTIVATION TO MODIFY THE DOCUMENTS

"To establish a *prima facie* case of obviousness . . . there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings" M.P.E.P. §2143.

Applicants reiterate that, among other deficiencies, there is no suggestion or motivation identified, either in the documents themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the teachings of Blum with those of Dai Nippon. For example, in the Response of 7 June 2005 (which is incorporated herein by reference), Applicants noted a lack of motivation to combine the coating compositions of Blum with the fiber cement substrates of Dai Nippon.

In preparing the Response of 7 June 2005, it was observed that the machine translation of Dai Nippon (supplied by the Examiner in the Final Office Action mailed 7 February 2005) *specified expressly* a lamination step of the top layer (5) in several sections (*See*, e.g., abstract, [0009]) but was unclear in other sections (*See*, e.g., [0014], [0019-0020]). It was believed that the unclear sections (*See*, e.g., [0014], [0019-0020]) dealt with the making of a lamination transfer sheet for the topcoat layer (5). On the basis of Dai Nippon's express statements regarding the lamination of the top layer, Applicants asserted that "Dai Nippon's

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lamination process does not exemplify the methods provided by the present invention" (e.g., page 3 of Response of 7 June 2005). In response, the Examiner asserted that the "Dai Nippon reference *seems* to teach coating liquid solutions or dispersions by teaching curtain flow coaters, paints, printing, and 'coatings' in general ([0014]; examples)" (e.g., page 5, Non-Final Office Action mailed 27 June 2005, emphasis added). To further evaluate these conflicting interpretations, a human translation of Dai Nippon was commissioned (see attachment). The human translation confirmed Dai Nippon's express statements regarding the lamination of the top layer (5) (See, e.g., abstract, [0009]), but also confirmed the Examiner's interpretation (See, e.g., [0014], [0019-0020]). Thus, Applicants respectfully submit that Dai Nippon also teaches the coating of the top layer (5) that does not involve lamination. Even in view of this, Applicants believe that the rejection is inappropriate and present the following additional remarks.

B. THE OBVIOUSNESS REJECTION CAN ONLY OCCUR BY THE IMPERMISSIBLE USE OF HINDSIGHT REASONING

Applicants continue to submit that the Examiner has engaged in the impermissible hindsight reconstruction of the claimed invention. The Examiner asserted that "any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such construction is proper" (e.g., page 6, Non-Final Office Action mailed 27 June 2005). Applicants respectfully submit that the Examiner's reasoning is incomplete. As recently asserted in *Princeton Biochemicals, Inc. v. Beckman Coulter, Inc.* 411 F.3d 1332, 75 U.S.P.Q.2d 1051 (Fed. Cir. 2005), 35 U.S.C. §103 specifically requires an assessment of the claimed invention "as a whole." The "as a whole" assessment of the invention requires a showing that an artisan of ordinary skill in the art at the time of the invention, confronted by the same problems as the inventor and with no knowledge of the claimed invention, would have selected the various elements from the cited references and combined them in the claimed manner. In other words, 35 U.S.C. §103 requires some

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suggestion or motivation, before the invention itself, to make the new combination. See *In re Rouffet*, 149 F.3d 1350, 1355-56, 47 U.S.P.Q.2d 1453, 1457-58 (Fed. Cir. 1998).

This "as a whole" instruction in 35 U.S.C. §103 prevents evaluation of the invention part by part. Without this important requirement, an obviousness assessment might successfully break an invention into its component parts, then find a reference corresponding to each component. This line of reasoning would import hindsight into the obviousness determination by using the invention as a roadmap to find its prior art components. Further, this improper method would discount the value of combining various existing features or principles in a new way to achieve a new result - often the essence of the invention. *Ruiz v. A.B. Chance Co.*, 357 F.3d 1270, 1275, 69 U.S.P.Q.2d 1686, 1690 (Fed. Cir. 2004). Simply identifying the various elements of a claim in the cited reference does not render a claim obvious. *Ruiz*, 357 F.3d at 1275. Instead, 35 U.S.C. §103 requires some suggestion or motivation in the prior art to make the new combination. *In re Rouffet*, 149 F.3d at 1355-56. Applicants submit that the Examiner has engaged in an improper part by part analysis of the claimed invention. Applicants submit that the requisite motivation to combine the teaching of Blum with Dai Nippon to obtain the claimed invention, as a whole, is lacking.

Applicants respectfully submit that neither Blum nor Dai Nippon address the problem of providing a coating that is "mar and abrasion resistant" (e.g., present claim 17). Therefore, there cannot be motivation to combine the documents to provide a method that results in such a product.

As such, Applicants respectfully submit that claims 17-18, 31-32, and 42-50 are not obvious over the combination of Blum and Dai Nippon. Applicants respectfully request reconsideration and withdrawal of the rejection.

The Examiner rejected claims 51-52 under 35 U.S.C. §103(a) as being unpatentable over Blum (U.S. Patent No. 5,344,873) in view of Dai Nippon (JP 10-128902), as applied to claims 17-18, 31-32, and 42-50 above, and further in view of the Applicants' admitted prior art. Applicants respectfully traverse this rejection.

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The Examiner asserted that "[t]he applicants admit that traditional practices using fiber cement board materials include a stacking operation for ease of shipping" (e.g., page 4, Final Office Action mailed 7 February 2005). As noted herein above, Applicants submit that there is no motivation for a person of ordinary skill in the art to combine the teachings of Blum and Dai Nippon. Nothing is identified within the Applicants' above statement that remedies this deficiency.

As such, Applicants respectfully submit that claims 51-52 are not obvious over the combination of Blum and Dai Nippon, and further in view of the Applicants' admitted prior art. Applicants respectfully request reconsideration and withdrawal of the rejection.

The Examiner rejected claims 33-41 under 35 U.S.C. §103(a) as being unpatentable over Blum (U.S. Patent No. 5,344,873) in view of Dai Nippon (JP 10-128902), as applied to claims 17-18, 31-32, and 42-50 above, and further in view of Takahashi (U.S. Patent No. 6,103,352). Applicants respectfully traverse this rejection.

Takahashi discloses a decorative sheet that comprises "a substrate sheet 1; a contiguous layer 4 provided on the substrate sheet 1; and a surface protective layer 5 provided on the contiguous layer 4 containing a compound having active hydrogen, the surface protective layer 5 comprising an ionizing radiation-curing resin and an isocyanate compound, the contiguous layer 4 and the surface protective layer 5 being in a cured state" (e.g., abstract). Further, Takahashi's decorative sheet possesses "high adhesive strength between the surface protective layer and each layer laminated onto the surface protective layer and, in addition, excellent scratch resistance" (e.g., column 1, line 31-34).

The Examiner asserted that Takahashi has been "relied upon as a secondary reference to provide teachings and motivation for using specific coating thicknesses and abrasion resistance agents" (e.g., page 2, box 11, lines 14-15, Advisory Action mailed 9 May 2005).

As noted herein above, Applicants submit that there is no motivation for a person of ordinary skill in the art to combine the teachings of Blum and Dai Nippon. Nothing is identified within Takahashi that remedies this deficiency.

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As such, Applicants respectfully submit that claims 33-41 are not obvious over the combination of Blum and Dai Nippon, as applied to claims 17-18, 31-32, and 42-50 above, and further in view of Takahashi. Applicants respectfully request reconsideration and withdrawal of the rejection.

The Examiner rejected claims 19 and 21 under 35 U.S.C. §103(a) as being unpatentable over Blum (U.S. Patent No. 5,344,873) in view of Dai Nippon (JP 10-128902), and Takahashi (U.S. Patent No. 6,103,352) as applied to claims 33-41 above, and further in view of Harper et al. (U.S. Patent No. 4,637,860). Applicants respectfully traverse this rejection.

Harper et al. disclose "a process for the manufacture of a non-asbestos corrugated sheet" (e.g. abstract). As noted herein above, Applicants submit that there is no motivation for a person of ordinary skill in the art to combine the teachings of Blum, Dai Nippon and Takahashi. Nothing is identified within Harper et al. that remedies this deficiency.

As such, Applicants respectfully submit that claims 19 and 21 are not obvious over the combination of Blum in view of Dai Nippon, and Takahashi as applied to claims 33-41 above, and further in view of Harper et al. Applicants respectfully request reconsideration and withdrawal of the rejection.

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Summary

It is respectfully submitted that the pending claims 17-19, 21 and 31-52 are in condition for allowance and notification to that effect is respectfully requested. The Examiner is invited to contact Applicants' Representatives, at the below-listed telephone number, if it is believed that prosecution of this application may be assisted thereby.

Respectfully submitted for
DARGONTINA et al.

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October 18, 2005

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CERTIFICATE UNDER 37 CFR §1.8:

The undersigned hereby certifies that the Transmittal Letter and the paper(s), as described hereinabove, are being transmitted by facsimile in accordance with 37 CFR §1.6(d) to the Patent and Trademark Office, addressed to **Mail Stop Amendment**, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 18 day of OCTOBER, 2005, at 1:25 pm (Central Time).

By: Sandy Truehart
Name: Sandy Truehart